

### **REMARKS**

This responds to the Office Action mailed on May 3, 2007.

No claims are amended, no additional claims are canceled; no claims are added; as a result, claims 1, 3-22, 24-27, 29-44, 47, 48 and 53-55 are now pending in this application, with claims 4, 6-22, 24, 25, 29-35, 40-43 and 53-55 withdrawn from consideration at this time.

As the Examiner noted in the Restriction Requirement mailed on January 18, 2007, claims 1, 7, 13, 27 and 41 are generic claims. Under 37 CFR 1.41, a generic claim may link a reasonable number of species. See MPEP 809.02. Linking claims must be examined with the elected claims, and should the linking claim be allowed, rejoinder of the inventions must be permitted. MPEP 809.

### **Interview Summary**

Applicant thanks Examiner Cristina O. Sherr for the courtesy of a telephone interview on June 8, 2007 with Applicant's representative, Barbara J. Clark. Ms. Clark sought clarification of the wording of the 35 USC 103 rejection which did not specifically state that it was "in view of Saito." Examiner Sherr confirmed that the rejection was intended to include the Saito reference. Examiner Sherr further agreed to contact Ms. Clark prior to sending out the next Office Action to discuss whether there appears to be any allowable subject matter. Ms. Clark thanks Examiner Sherr for the courtesies extended during the interview.

### **§103 Rejection of the Claims**

#### **1) The Applicable Law**

As discussed in *KSR Int'l. Co., v. Teleflex, Inc.*, 127 S. Ct. 1727, 82 USPQ2d 1385 (2007), the determination of obviousness under 35 U.S.C. §103 is a legal conclusion based on factual evidence. See *Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, 411 F.3d 1332, 1336-37 (Fed.Cir. 2005). The legal conclusion that a claim is obvious within §103(a), depends on at least four underlying factual issues set forth in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966): (1) the scope and content of the prior art; (2) differences

between the prior art and the claims at issue; (3) the level of ordinary skill in the pertinent art; and (4) evaluation of any relevant secondary considerations.

The Examiner has the burden under 35 U.S.C. §103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *M.P.E.P.* § 2142 (citing *In re Vaeck*, 947 F.2d, 488, 20 USPQ2d 1438 (Fed. Cir. 1991)).

Additionally, there must be a rational underpinning grounded in evidence to support the legal conclusion of obviousness. See *In re Kahn*, 78 USPQ2d 1329 (Fed. Cir. 2006), which states that, “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn* citing *In re Lee*, 61 USPQ2d 1430 (Fed. Cir.2002). Additionally, “mere identification in the prior art of each element is insufficient to defeat the patentability of the combined subject matter as a whole.” *In re Kahn*.

A showing of “teaching, suggestion, or motivation” to combine the prior art to meet the claimed subject matter could provide a helpful insight in determining whether the claimed subject matter is obvious under 35 U.S.C. § 103(a). USPTO Memorandum, *Supreme Court Decision on KSR Int’l. Co., v. Teleflex, Inc.*, p. 1, ¶ (2) (May 3, 2007). The court in KSR rejected a rigid application of the “teaching, suggestion, or motivation” (TSM) test, which required a showing of some teaching, suggestion, or motivation in the prior art that would lead one of ordinary skill in the art to combine the prior art elements in the manner claimed in the application or patent before holding the claimed subject matter to be obvious. *Id.* ¶ (3). The court in KSR noted, however, that the analysis supporting a rejection under 35 U.S.C. § 103(a) should be made explicit, and that it was “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *Id.* p. 2, ¶ (4).

Specifically, the Office Action must provide specific, objective evidence of record for a

finding of a suggestion or motivation to combine reference teachings and must explain the reasoning by which the evidence is deemed to support such a finding. *See KSR Int'l Co p. 1399*, citing *In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006); *In re Sang Su Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

Even if adding an element to a prior art was obvious, that does not establish that the claimed invention encompasses obvious subject matter. USPTO Memorandum, *KSR Int'l. Co.*, *supra*, p. 19, ¶ 1. Instead, the following factors can still be considered to determine whether a claimed invention at issue is nonobvious under 35 U.S.C. §103(a): (1) whether the claimed invention yields more than predictable results (*id.* p. 12, ¶¶ 1-2); (2) whether there is technical difficulties in combining the prior arts, requiring substantial reconstruction or redesign (*id.* p. 19, ¶ 1); (3) whether the prior art cannot be upgraded to or teaches away from the claimed invention (*id.* p. 22, ¶ 2); (4) whether the prior arts have secondary factors which may 'dislodge' obviousness – "long felt and unresolved needs", "the failure of others", "commercial success" (*id.* p. 2, ¶ 3); and (5) whether the prior arts require elements of the invention to be read using hindsight to be relevant to the claimed invention (p. 17, ¶ 3).

Therefore, the test for obviousness under §103 must take into consideration the invention as a whole; that is, one must consider the particular problem solved by the combination of elements that define the invention. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir.1985). The Examiner must, as one of the inquiries pertinent to any obviousness inquiry under 35 U.S.C. §103, recognize and consider not only the similarities but also the critical differences between the claimed invention and the prior art. *In re Bond*, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990), *reh'g denied*, 1990 U.S. App. LEXIS 19971 (Fed. Cir.1990). The fact that a reference teaches away from a claimed invention is highly probative that the reference would not have rendered the claimed invention obvious to one of ordinary skill in the art. *Stranco Inc. v. Atlantes Chemical Systems, Inc.*, 15 USPQ2d 1704, 1713 (Tex. 1990). When the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious. *Id.* p. 4 citing *United States v. Adams*, 383 U.S. 39, 51-51 (1966). Additionally, critical differences in the prior art must be recognized (when attempting to combine references). *In re Bond*, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990), *reh'g denied*, 1990 U.S. App. LEXIS 19971 (Fed.

Cir.1990).

In order to take into account the inferences which one skilled in the art would reasonably make, the examiner must ascertain what would have been obvious to one of ordinary skill in the art at the time the invention was made. *M.P.E.P.* § 2141.03 (citing *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 218 USPQ 865 (Fed. Cir. 1983), *cert. denied*, 464 U.S. 1043 (1984)).

The examiner must step backward in time and into the shoes worn by the hypothetical “person of ordinary skill in the art” when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention “as a whole” would have been obvious at that time to that person. Knowledge of Appellants’ disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the “differences,” conduct the search and evaluate the “subject matter as a whole” of the invention. The tendency to resort to “hindsight” based upon Appellants’ disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

*M.P.E.P.* § 2141.03.

Finally, rigid preventative rules that deny factfinders recourse to common sense . . . are neither necessary under our case law nor consistent with it. *KSR Int’l Co.*

2) *Application of 35 USC §103 to the Rejected Claims*

Claims 1, 3, 5, 27, 30, 36-39, 44, 47 and 48 were rejected under 35 USC § 103(a) as being unpatentable over Misra et al. (U.S. 5,999,711). Applicant understands that the claims were alleged to be unpatentable over Misra *in view of Saito*.

The Examiner states that the references teach various elements of the claims.

Furthermore, claims 3-5, 30, 36-39, 44, 47 and 48 are dependent claims. The additional limitations provided in dependent claims cannot by themselves be rendered obvious over the cited references if the independent claim from which it depends is determined to be nonobvious.

Misra discusses a method and system for providing certificates holding authentication and authorization information for users/machines. If proper authentication is received, the principal is allowed to log on to the distributed system. As the Examiner admits, Misra does not disclose authenticating the user identity through at least two authentication mechanisms.

Saito does not overcome the deficiencies of the primary reference. Saito discusses a security management method for a network system which uses an integrated certificate.

Clearly the methods in the primary reference and the methods in the secondary references are fundamentally different from each other and such critical differences must be recognized (when attempting to combine references) according to *In re Bond*, supra. Additionally, a person of ordinary skill in the art *having common sense* at the time of the invention would not have reasonably looked to Misra to solve problems already solved by Saito.

Applicant respectfully submits that neither Misra or Saito, alone or in combination, teach or suggest the methods as taught by Applicant and claimed in claims 1 and 27. Again, Applicant explicitly teaches and claims in claim 1 a method of providing an authentication service, comprising with an authentication server, relating a user identity to a set of authentication mechanisms, the user identity belonging to a user; relating a type of transaction with a relying party to a level of authentication, the relying party reliant on the authentication service to authenticate the user before user access is provided to its service, program or information; the user or relying party selecting at least two authentication mechanisms to input from the set of authentication mechanisms according to the level of authentication associated with the type of transaction, wherein a flexible authentication process is provided; and authenticating the user identity through the at least two authentication mechanisms, wherein the user is granted or denied access to the service, program or information provided by the relying party. Applicant also explicitly teaches and claims in claim 27 a method of providing an authentication service, comprising with an authentication server, providing a list of supported authentication methods to authenticate at least one user; receiving requirements for an authentication level from at least one relying party, the at least one relying party reliant on the authentication service to authenticate the at least one user before user access is provided to its service, program or information receiving a selection of at least two authentication methods from the at least one user, wherein a flexible authentication process is provided and the selection can include a subset of the list of supported authentication methods; receiving identification information for the at least one user; producing a portfolio associated with the at least one user, the portfolio comprising the list of authentication methods, each authentication method in the portfolio meeting the selection of the at least one user, each authentication method in the

portfolio supported by an authentication system, the list of authentication methods meeting the requirements for the authentication level from the at least one relying party; and relating the identification information to the portfolio for the at least one user.

Applicant cannot find, in Misra, as alleged on page 3 of the Office Action, a method which includes “relating a type of transaction with a relying party to a level of authentication” as recited in claim 1. As a result, Misra does not provide a “flexible authentication process” as recited in the claims.

Therefore, the current Office Action has failed to meet the burden under 35 U.S.C. §103 to establish a *prima facie* case of obviousness as required by the MPEP and *In re Fine*. Only conclusory assertions have been made, without articulating the reasoning for making the combination, i.e., the combination has no rational underpinning as required.

There is also no reasonable expectation of success with the proposed combination.

An additional requirement of the *prima facie* case is that the references must teach or suggest all the claim limitations. Neither reference teaches or suggests, for example, the user or relying party selecting at least two authentication mechanisms to input from the set of authentication mechanisms according to the level of authentication associated with the type of transaction, wherein a flexible authentication process is provided as recited in claim 1 or receiving a selection of at least two authentication methods from the at least one user, wherein a flexible authentication process is provided and the selection can include a subset of the list of supported authentication methods, as recited in claim 27. Since all of the elements of the claims are not found in the references, Applicant assumes the Examiner is taking Official Notice of the missing elements from an undisclosed source. Applicant respectfully objects to the taking of Official Notice, and pursuant to MPEP 2144.03, Applicant traverses the assertion of Official Notice and requests that the Examiner cite a reference that teaches the missing element. If the Examiner cannot cite a reference that teaches the missing element, Applicant respectfully requests that the Examiner provide an affidavit that describes how the missing element is present in the prior art. If the Examiner cannot cite a reference or provide an affidavit, Applicant requests withdrawal of the rejection and reconsideration and allowance of the claims.

The differences between the prior art and the claims at issue must also be considered as required by *Graham v. John Deere Co. of Kansas City*, supra. For example, there is no indication

of any appreciation of the problem being solved by Applicant's invention. Misra is seeking to solve the problem of providing a secure system which supports roaming users or roaming machines. The solution includes avoid replication of credentials across the system using a *fixed* authentication process which either grants or denies a request to log on or connect to a distributed system. Saito is seeking to solve the problem of providing integral management of a user and a centralized management of network resources which cover both a wide area network system and an intra-enterprise network system. The solution includes providing a security management method which facilitates shifting of the existing user authentication scheme based on a used ID and a password to the single on-sign based on utilization of an integrated certificate. In contrast, Applicant is seeking to solve at least the problem of providing a *flexible* authentication process without requiring a common integrated certificate as in Saito. The solution includes relating a type of transaction with a relying party to a level of authentication. Such an advantage flows only from Applicant's invention. It is not clear how one of ordinary skill in the art would apply Applicant's solution to their problems.

Regarding claims 3, 36-39 and 5, mentioned separately on pages 3 and 4 of the Office Action, Applicant traverses these statements and again notes that these claims are dependent claims which depend on independent claim 1 or 27, which are allowable for all the reasons stated herein.

The references neither independently, or combined, contain each and every element of Applicant's claimed invention as required. Applicant respectfully submits that independent claims 1 and 27, and the claims that depend therefrom are patentably distinct from the cited references, either alone or in combination. Claims 1, 3, 5, 27, 30, 36-39, 44, 47 and 48, each viewed as a whole, are not suggested by the cited references and not obvious under 35 USC 103(a).

Reconsideration and withdrawal of this rejection is respectfully requested.

#### RESERVATION OF RIGHTS

Applicant reserves the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicant does not admit that any of the cited references or any other references of record are

relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner's personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, Applicant timely objects to such reliance on Official Notice, and reserves all rights to request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03. Applicant reserves all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.

### **CONCLUSION**

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (515-233-3865) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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